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09/034,313 03/04/98 CLAXTON

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BIRCH STEWART KOLASCH & BIRCH
8110 GATEHOUSE ROAD
SUITE 500 EAST
FALLS CHURCH VA 22042

VERDIER, C

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 17

Application Number: 09/034,313

Filing Date: March 4, 1998

Appellant(s): Ernest J. Claxton et al.

Terrell C. Birch
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed January 29, 2001.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

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A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that all rejected claims (claims 15-16, 19-21, and 24-25) stand or fall together.

(8) *ClaimsAppealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

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(10) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

Claims 15-16, 19-21, and 24-25 are rejected under the “Recapture Doctrine”. This rejection is set forth in prior Office action, Paper No. 13, pages 2-7.

(11) *Response to Argument*

Appellants have argued on page 4, last line, and page 5, lines 1-6 that Appellants find no legal authority that supports the examiner’s application of the recapture rule, and that the courts have consistently viewed the recapture rule as applying, if at all, to a reissue claim that is at least as broad as a preamended or canceled application claim, and further, that the claims at issue in this appeal are materially narrower than preamended independent claim 1 of U.S. application 08/321,857, and therefore the recapture rule is inapplicable in this case.

On page 7, Appellants have argued that the federal Circuit and its predecessor court have recognized that surrendered claim scope resulting from amending or canceling claims relates, when applicable to all, to a surrender of pre-amended or canceled claim scope, and not a claim scope that is materially narrower than the pre-amended or canceled claim.

On page 8, first paragraph, Appellants have cited *In re Clement*, 45 USPQ2d at 1164 and state that the recapture rule does not apply in the absence of evidence that the applicant’s amendment was an admission that the scope of the [pre-amended or canceled claim] was not in

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fact patentable. On page 8, second paragraph, Appellants have argued that the legal authority consistently defines “surrendered” claim scope in terms of pre-amended or canceled claims, or at least based upon an argument made by the Applicant to overcome a prior art rejection. On page 8, second paragraph, and page 9, first paragraph, Appellants have argued that in *Ball Corp. v United States*, the Court equated a pre-amended claim with a canceled claim for recapture purposes, and agreed with the lower Court that the recapture rule did not apply to the case at issue because the reissue claims were intermediate in scope, i.e. broader than the claims of the original patent yet narrower than the canceled claims.

On page 9, second paragraph, Appellants have cited in *In re Byers*, for a definition of surrendered subject matter in terms of canceled or pre-amended claim scope. On page 9, last paragraph, Appellants have argued that the recapture rule may be overcome by including relevant narrowing amendments, and that even if the recapture rule were to apply to the facts of this application, the details of the claimed bearing cartridge that have been included in reissue claims 15, 16, 19-21, 24, and 25 sufficiently narrow these claims to overcome the recapture rule rejection.

It is respectfully submitted that, contrary to Appellants’ above arguments that the recapture rule does not apply to the case at hand, the recapture rule does in fact apply, and that

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In re Clement provides controlling legal authority as to the rejection based upon recapture. As set forth in *In re Clement*, the recapture rule bars patentee from regaining, through reissue, subject matter surrendered in an effort to obtain allowance of original claims as set forth in *Mentor Corp v. Coloplast, Inc.*, 998 F.2d at 995, 27 USPQ2d at 1524, and the recapture rule bars a reissue claim that is broader than the canceled claim or amended claim in some aspects, but narrower in others, if the reissue claim is as broad or broader in an aspect germane to the prior art rejections, *Id.* at 996, 27 USPQ2d at 1525. *In re Clement*, at 1164, states that “deliberate withdrawal or amendment ... cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. 251.” citing in *Haliczer v. United States*, 356 F.2d 541, 545, 148 USPQ 565, 569 (Ct. Cl. 1966). Furthermore, *Clement* states that deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable. *Mentor*, 998 F.2d at 995-96, 27 USPQ2d at 1524-25; *Ball Corp. v. United States*, 729 F.2d at 1438, 221 USPQ at 296; *Seattle Box Co. v. Industrial Crating & Packing, Inc.*, 731 F.2d at 826, 221 USPQ at 574.

In re Clement also notes that acquiescing in a rejection and accepting a patent whose claims include the limitation added by the applicant to distinguish the claims from the prior art

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shows intentional withdrawal of the subject matter as set forth in *Haliczer*, 356 F.2d at 545, 148 USPQ at 569. *Clement*, at 1164, notes that amending a claim by the inclusion of an additional limitation has exactly the same effect as if the claim as originally presented was canceled and replaced by a new claim including that limitation, citing *In re Byers*, 230 F.2d 451, 455, 109 USPQ 53, 55 (CCPA 1956). Finally, *Clement* at 1165 states that “if the reissue claim is broader in some aspects, but narrower in others, then: (a) if the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim;”.

Because then pending claim 1 in the application 08/321,857 which matured into U.S. Patent 5,496,150 was rewritten to include the allowable features of then pending dependent claim 4, the subject matter of **claim 1** in the issued patent was surrendered in order to overcome the prior art. The reason that then pending claims 4-15 were allowable over the prior art of record in the application 08/321,857 which matured into U.S. Patent 5,496,150 was that the prior art did not teach a bearing cartridge separably fastened within the diffuser core, with the bearing cartridge carrying axially spaced bearings. Hacker, which was of record in application 08/321,857 discloses in figures 1 and 2 two separate, removable bearing cartridges that each carry a single bearing, with the bearing cartridge 42 being in the diffuser core. The deletion of the language which was added to claim 1 (the separable bearing cartridge which includes axially spaced

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bearings as recited in claim 1, lines 23-26) of the issued patent in order to overcome the prior art and substitution of broader language in reissue claims is a violation of the Recapture Doctrine.

In *Clement*, the court elucidated a detailed method of analyzing whether or nor the recapture rule applies. The court explicitly stated that the first step in applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. The first Office action in application 08/321,857 clearly set forth the explicit language that was in the patent claims but was removed from the reissue claims.

In *Clement*, the Court said that the second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether an applicant surrendered particular subject matter, one looks to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. The first Office action in application 08/321,857 clearly pointed out what language was added to patent claim 1 to overcome the prior art rejection, make it allowable over the prior art, and cause the patent to issue.

The reissue claims have tried to remove claim language which was explicitly added to overcome a prior art rejection and therefore the reissue claims have been broadened in a material aspect, i.e., in an aspect that was material to the rejection that was overcome by adding the

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language now sought to be removed. On balance, reissue claims 15-16, 19-21, and 24-25 are broader in a manner directly pertinent to the subject matter that Applicants surrendered (what was added to then pending claim 1 to make it allowable and issue as patent claim 1) during the prosecution of the patent. By affirmatively choosing to amend claim 1 to incorporate the allowable features of dependent claim 4 in order to obtain a patent, the patentees have effectively surrendered any subject matter broader than that recited in amended claim 1.

On page 11, first paragraph, Appellants have argued that the Appellants did not consider the inclusion of a plurality of bearing cartridges to be a significant aspect of their invention, and on page 11, second paragraph, that nothing in the disclosure of the '857 application suggests that Appellants considered a plurality of axially spaced bearings a significant feature for establishing patentability, and that the '857 application placed no emphasis on this feature of the disclosed embodiment.

These arguments are not persuasive because column 1, lines 65-67 of U.S. Patent 5,496,150 (into which application 08/321,857 matured as a patent) states that an object of the invention is "to provide a solids-handling vertical turbine pump having bowl bearings which can be readily serviced in the field." Column 2, lines 18-29 state that the "objects of the invention are also realized by a vertical turbine including ... said bearing cartridge carrying axially spaced bearings which surround and rotatably support said drive shaft." It is respectfully submitted that

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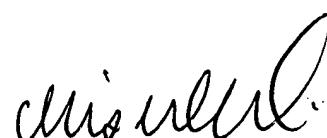
these above mentioned portions indicate that a plurality of axially spaced bearings is a significant feature of the invention because Appellants mentioned this feature in the "Summary of the Invention" section, and stated that the feature of the bearing cartridge carrying axially spaced bearings realizes one of the objects of the invention, i.e. providing a solids-handling vertical turbine pump having bowl bearings which can be readily serviced in the field.

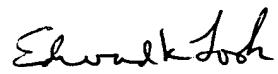
It is also respectfully submitted that Appellants acquiesced by not providing comments concerning the examiner's statement as to the reasons for allowance of claims 4-15, set forth in the first Office action in application 08/321,857, paper number 5. Appellants had the opportunity to comment on the reasons for allowance in response to the first Office action, and the opportunity to comment on the reasons for allowance after the Notice of Allowability was mailed in the second Office action, paper number 8, if they did not agree with the examiner's statement of reasons for allowance, or if they wanted to provide clarification. Appellants had ample opportunity which included the time period of up to no later than the payment of the issue fee to file such a statement, yet constructively elected not to file comments concerning the examiner's statement as to the reasons for allowance of claims 4-15. Thus, it would appear that Appellants agreed with the reasons for allowance of claims 4-15.

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For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,


Christopher Verdier
Primary Examiner
Art Unit 3745
February 23, 2001


Edward K. Look
Appeal Conferee


Thomas E. Denion
Appeal Conferee


Thomas E. Denion
Primary Examiner